

**REMARKS****A. Election/Restriction**

In the instant Office Action, the Examiner has required an Election/Restriction, alleging that Claims 177, 179-189 (Examiner's Species A, herein "Species A") are patentably distinct from Claim 178 (Examiner's Species B, herein "Species B"). The Applicants provisionally elect, with traverse, the alleged Species A (Claims 177, 179-189). For the reasons stated below, Applicants respectfully assert that the Examiner's Election/Restriction is misplaced and should be withdrawn.

The Examiner has examined all pending claims (both Species A and Species B) **five times**. Further, the Examiner has stated that the pending claims "recite the same claim limitations." Office Action, dated December 6, 2000, page 8. Applicants assert that the Examiner has had ample opportunity to examine the instant claims and that the Examiner's continued examination of the instant claims would place no additional burden on the Examiner than has been carried already. See MPEP §803. Consequently, Applicants respectfully request the withdrawal of the current Election/Restriction.

**B. The Examiner has Failed to Make a *Prima Facie* Case for Election/Restriction**

A proper application of a Election/Restriction requires that the Examiner make a *prima facie* case that i) the inventions are independent or distinct as claimed, and ii) the search and examination of the entire application creates a serious burden on the Examiner. See MPEP §803. "Examiners must provide reasons and/or examples to support conclusions...." *Id.* The Examiner has stated that "[t]his application contains claims directed to...distinct species of the claims invention..." Office Action, dated June 7, 2004, page 2. The Examiner has failed to provide reasons or examples as to why the inventions are independent or distinct as claims and that the examination would create a serious burden on the Examiner. As the Examiner has failed to comply with the requirements of the MPEP as to proper application of Election/Restriction, Applicants respectfully request that the Election/Restriction be reconsidered and withdrawn.

**C. Summary of the Examiner's Examination of the Instant Claims**

Throughout prosecution of the instant application, the Examiner has continually grouped Claim 178 with claims from Species A. As recently as the last Office Action, dated December 12, 2002, the Examiner placed a §103(a) rejection against both of the Examiner's species together without distinguishing the claims' limitations. *See*, Office Action, dated December 12, 2002, page 8 ("Claims 177-189, 195 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPTO organization, in view of Canale at al...."); *See also*, *Id.* at page 13 ("Re. to claims 177-189: USPTO also suggest these claims [sic] limitations because they 'read-on' analogous steps of 'expert matching....'"); *Id.* at page 14 (Claims 177-179, 185 are rejected under 35 U.S.C. 103(a) as being unpatentable over Levin et al...."). Further examples of the Examiner's concurrent examination of the instant claims are found numerous times. *See*, Office Action, dated April 1, 2002, paragraph 10 (Claims 177-179, 185 are rejected under under 35 U.S.C. 103(a) as being unpatentable over Levin et al...."); Office Action, dated June 19, 2001, page 10 (Claims 177-189, 193-195 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nielsen (U.S. Pat. 5,948,054), in view of Harte (U.S. Pat. 4,576,579)"); Office Action, dated December 6, 2000, page 3 (Claims 177-189, 192-195 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nielsen (U.S. Pat. 5,948,054), in view of Harte (U.S. Pat. 4,576,579), and in further view of the Official Notice."); *Id.* (Claims 177-178 are rejected because they 'read-on' the steps of 'expert matching....'"); *Id.* at page 8 ("Referring to claims 177-189: The limitations of these claims recite the same claim limitations as claims 192-195 discussed above."); Office Action, dated May 11, 2000 ("Claims 1, 67, 113, 177, 178, and 179-192 are rejected under 35 U.S.C. §102 as being unpatentable over Harte (U.S. Pat. 4,576,579), in view of the Office Notice.").

**D. A *Prima Facie* Case for "Independent" Restriction has not been Established**

The Examiner makes no statements alleging that the claimed inventions are "independent." However, even if the Examiner had intended to impose the restriction based on "independent" inventions, the *prima facie* burden has still not been met. Applicants respectfully point out that "independent" inventions, as defined in restriction

practice, are “not connected in design, operation, or effect, MPEP §§802.01, 808.01, and are “not capable of use together.” MPEP §§808.01, 806.04. An example of “independent” inventions would be claims directed to both “a necktie and a locomotive bearing.” *See* MPEP §808.01 at Examiner Note 1; *see also*, MPEP §806.04 (“a shoe, and a locomotive bearing”). Clearly, where all currently claimed embodiments of the present invention are related to methods “to facilitate and support expert-based commerce”, no such independence exists.

**E. A *Prima Facie* Case for “Distinct” Restriction has not been Established**

Alternatively, even if the Examiner had intended to impose the restriction based on “distinct” inventions, the *prima facie* burden has still not been met. No reasons for believing the claimed inventions are “distinct” have been set forth, nor has the Examiner complied with the second requirement of presenting reasons for insisting upon restriction.

The Examiner has failed to show that (1) that each claimed invention “has attained recognition in the art as a separate subject for inventive effort, and also a separate field of search,” (2) that even if classified together they have formed separate subjects for inventive effort, or (3) that a different field of search is required. *See* MPEP §808.02. Absent such showings as required by MPEP §808.02, no *prima facie* case for restriction under the “distinct” theory is established. Where “the classification is the same and the field of search is the same and there is no clear indication of separate future classification and field of search, no reasons exist for dividing among related inventions.” *Id.*

**F. Claims are in Proper Genus/Species Relationship**

As currently entered, Claim 178 contains all of the limitation of claim 177, part of Examiner’s Species A, and is therefore a proper specie of the genus described by Claim 177. Further, the Examiner has not presented any statements directed to genus and species restriction such as (1) how the species are believed to be mutually exclusive, (2) whether the species are believed to be directed to different claimed embodiments, or (3)

describing how conducting a search and examining the application as a whole would be burdensome to the Examiner.

Indeed, Applicants note that the search has already been completed and that the claims have been examiner **five times**, removing any possibility of a burden based on search scope or magnitude. Accordingly, Applicants respectfully request reconsideration of the Election/Restriction and withdrawal of the same.

**G. The Examiner has Failed to Establish an Undue Burden**

Even if a *prima facie* case for restriction establishes that an application includes independent or distinct inventions, restriction is not proper “[i]f the search and examination of [the] entire application can be made without serious burden.” MPEP §803. Applicants respectfully assert that restriction is not proper in this case because there is no indication that any serious burden exists as the instant claims have already been examiner together **five times**. In particular, the Examiner has failed to show that (1) there is no separate classification of the alleged species which would necessitate a separate field of search; (2) the alleged species can be searched using the same field of search without unduly burdening the Examiner; and (3) the alleged species are not related to any class of invention which has achieved a separate status in the art. *See, MPEP* §808.02.

In general, Applicants believe that the claims all can readily be searched and examined together without undue burden on the Examiner. Indeed, as mentioned *supra*, such a non-burdening search has already been conducted. Thus, without further showing of an undue burden upon the Examiner, Applicants respectfully assert that the Examiner has failed to meet all of the requirements of the MPEP to make a proper Election/Restriction of the instant claims.

**CONCLUSION**

In view of the foregoing, Applicants respectfully request that the restriction requirement be withdrawn upon reconsideration. It is submitted that all of the claims are in condition for allowance. The Examiner's early re-examination and reconsideration are respectfully requested.

If the Examiner has any questions regarding this response or the present application, the Examiner is cordially requested to contact Jason Skinder at telephone number 203-461-7017 or via electronic mail at [jskinder@walkerdigital.com](mailto:jskinder@walkerdigital.com).

Respectfully submitted,

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